

REMARKS

Claims 1-9 and 11-16 are pending in the present application. Claims 3 and 12 have been amended to correct an obvious clerical error. No new matter has been added. Applicants maintain that, in view of the amendments and remarks below, the application is in condition for allowance and respectfully request a Notice of Allowance.

CLAIM OBJECTIONS

Claim 3 stands objected to for misspelling “chimeric”. Applicants have amended claims 3 and 12 to correct this typographical error and to properly recite “chimeric”. Applicants therefore respectfully request that the objection to this claim be withdrawn. The February 7, 2003 Office Action states that applicants’ prior amendment to correct this defect in claim 3 was not entered because it was not properly submitted under 37 C.F.R. 1.121. Applicants respectfully submit that Rule 1.121 does not apply to amendments in reissue applications but that such amendments are covered by Rule 1.173(b)(2). Applicants maintain that the amendment to claim 3 above is in compliance with Rule 1.173(b)(2).

CLAIM REJECTIONS

REISSUE OATH/DECLARATION

Claims 1-9 and 11-16 are rejected as being based upon a defective oath/declaration under 35 U.S.C. §251. Applicants herewith submit a substitute reissue oath/declaration in compliance with 37 C.F.R. §1.175. Therefore, the rejection of these claims should be withdrawn.

THE 35 U.S.C. §251 REJECTION

Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 9 and 11-16 under 35 U.S.C. §251 as allegedly being an improper recapture of broadened claimed subject matter surrendered in parent application (USSN 08/483,186) for the patent (US 5,689,197) upon which the present reissue is based. In the rejection, the Examiner alleges “that Applicant surrendered subject matter drawn to ‘immunological binding characteristic of monoclonal antibody 4G9’ in the Interview Summary dated 5/27/97” in parent application USSN

08/483,186 (*See*, Office Action at page 3). The Examiner asserts that the surrendered subject matter of the parent case and the instant claims of the reissue are drawn to genus claims using binding characteristics of the deposited 4G9 monoclonal as reference points (*See*, Office Action at page 3). Applicants respectfully traverse.

With respect to the applicability of the recapture doctrine, Applicants note that MPEP 1412.02 requires “(t)he record of the original application must show that the broadening aspect (the omitted/broadened limitation(s)) relates to subject matter that the Applicant previously surrendered.” Applicants maintain that the present language recited in claim 9 is not subject matter surrendered during prosecution of parent application USSN 08/483,186. The examiner characterizes the subject matter applicants are allegedly surrendered as the “binding characteristics of the deposited 4G9 monoclonal antibody as reference point.” However the claims as issued contained the limitation that the claimed composition of matter could comprise an antigen binding fragment of the 4G9 antibody “reactive with in vivo produced advanced glycosylation endproducts (AGEs)”. Further issued claim 2 specifically recited that the claimed composition of matter was an antibody 4G9 or fragment thereof which “specifically binds to serum-AGE proteins, serum-AGE lipids, serum-AGE peptides, LDS-AGE, Hb-AGE or collagen-AGE.” Thus, since the antibody fragments claimed referred to the binding characteristics of the whole 4G9 antibody, the claimed subject matter in the issued claims covered compositions of matter having “binding characteristics of the deposited 4G9 monoclonal antibody as reference point.” No such subject matter was surrendered during prosecution. Applicants therefore respectfully request the reconsideration and withdrawal of the rejection under 35 U.S.C. §251.

CONCLUSION

On the basis of the foregoing amendments and remarks, Applicants respectfully submit that the pending claims are in condition for allowance and a Notice of Allowance for the pending claims is respectfully requested. If there are any questions regarding this application that can be handled in a phone conference with Applicants' Attorneys, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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Dated: August 7, 2003